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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/025,531	02/18/1998	JOHN A. BECKMAN	1-5119	9696

27210 7590 08/27/2003

MACMILLAN, SOBANSKI & TODD, LLC  
ONE MARITIME PLAZA - FOURTH FLOOR  
720 WATER STREET  
TOLEDO, OH 43604

EXAMINER
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NGUYEN, TRINH T

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/025,531	BECKMAN, JOHN A.
Examiner	Art Unit	
Trinh T Nguyen	3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 18 July 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 29-32 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 29-32 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Continued Examination under 37 CFR 1.114 After Final Rejection***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/18/03 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 29-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Horton et al.** (US 5,862,877) in view of **Shah et al.** (US 5,666,840).

**Horton et al.** disclose a method for manufacturing a vehicle frame assembly that is adapted to be resiliently supported upon a plurality of vehicle wheels by a suspension system and is adapted to serve as a platform upon which a body portion of the vehicle can be mounted comprising the steps of: providing first and second side rails (12, 14) that each extend the entire length of the vehicle frame assembly (10); hydroforming the first and second side rails; providing a plurality of cross members (24, 26); securing the

cross members to the first and second side rails to form a vehicle frame assembly that is adapted to be resiliently supported upon a plurality of vehicle wheels by a suspension system and is adapted to serve as a platform upon which a body portion of the vehicle can be mounted; and connecting a component of vehicle directly to the integrally mounting structure of the first and second side rails without using brackets or other mounts (see lines 1-50 of col. 5).

**Horton et al.**'s method does mention that the frame members (i.e., the first and/or the second side rails and/or the cross member) are formed by a hydroforming process and that the frame members have integrally formed mounting structures (50, 52, 38, 43, 202, 60, 42) thereon. However, **Horton et al.**'s method does not indicate that the frame members are hydroformed so as to have an integrally formed mounting structures thereon and that the mounting structures are apertures.

**Shah et al.**, on the other hand, teach a method of hydroforming a tubular frame members (10) to a final shape as well as forming integrally formed mounting structures (40) thereon (see Figures 1-5, and further note that the integrally formed mounting structures are apertures). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified **Horton et al.**'s hydroforming technique so as to have included **Shah et al.**'s hydroforming technique, since to do so would eliminate an extra manufacturing step for forming the mounting structure separately (i.e., by using **Shah et al.**'s hydroforming technique, one can hydroform and form mounting structures on the frame member simultaneously).

For claim 30, note that in lines 55-67 of col. 8 and lines 1-3 of col. 9, **Horton et al.**

further disclose the step of hydroforming the frame members (i.e., the first and/or the second side rails and/or the cross member) to form protrusions (330) thereon.

For claim 31, note that lines 55-67 of col. 8 and lines 1-3 of col. 9 and Figures 1 & 3 indicate that the protrusions formed on the first and second side rails are oriented "to extend respectively from the first and second side rails toward one another".

### ***Response to Arguments***

4. Applicant's arguments filed 7/18/03 have been fully considered but they are not persuasive.
5. In response to Applicant's argument that Horton's engine cradle assembly is not a vehicle frame assembly, the Examiner disagrees. A fair reading of the claim language permits the Examiner to interpret Horton's engine cradle assembly as a vehicle frame assembly since the engine cradle assembly does include similar structures (i.e. a pair of side rails having integrally formed mounting structure and cross members) as the vehicle frame assembly as claimed by the Applicant. Also, Horton's engine cradle assembly is capable of performing the same function as Applicant's vehicle frame assembly (i.e., both are adapted to be resiliently supported upon a plurality of vehicle wheels by a suspension system and are adapted to serve as a platform for a body portion of the vehicle can be mounted). Furthermore, it is noted that the recitation "adapted to be resiliently supported upon a plurality of vehicle wheels...a body portion of the vehicle can be mounted" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a

structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In this case, the preamble is not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention.

6. In response to Applicant's argument that neither Horton nor Shah disclose "the claimed method wherein the first and second side rails are hydroformed so as to have respective integrally formed mounting structures that are oriented so as to extend toward one another so that a component of the vehicle can be connected directly to such integrally formed mounting structures without the use of brackets or other mounts", Applicant is directed to paragraph # 3 above for further explanation.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Trinh T Nguyen whose telephone number is (703) 306-9082. The examiner can normally be reached on M-F (9:30 A.M to 6:00 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan can be reached on (703) 306-4159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

ttn  
August 22, 2003

Charles T. Jordan  
CHARLES T. JORDAN  
C. T. JORDAN, PTO  
U.S. PATENT AND TRADEMARK OFFICE